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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,868	03/26/2001	Rabindranath Dutta	AUS9-2001-0229-US1	8113

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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,868

Applicant(s)

DUTTA, RABINDRANATH

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-18, and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION***Response to Amendment***

The Applicant canceled Claims 7 and 19, amended all independent claims, and based arguments on the amended Claims. All pending claims (1-6, 8-18, and 20) were examined in this final Office Action necessitated by amendment.

Response to Arguments**Rejection under 35 USC 101**

The Applicant argues Claims 13-18 and 20 were improperly rejected and based arguments on In re Beauregard. The Applicant notes that these computer product claims are directed to statutory subject matter and merely correspond to the method Claims 1-6 and 8. The Examiner is withdrawing the rejection of Claims 13-18 and 20. Treating these claims under 35 USC 112, 6th paragraph, the Examiner found sufficient evidence of programmable means to support means plus function, which removes the Examiner's previous concern about the preamble not conveying execution of the stored program product.

Further review of the amended Claim 1 reveals a lack of practical application of technological arts. Claims 1, 2, 5, 6, and 8 are rejected under 35 USC 101.

Please see below. Rejection Under 35 USC 101.

Rejection under 35 USC 102

Applicant's arguments filed 25 May 2004 have been fully considered but they are not persuasive.

The Applicant respectfully traversed the Examiner's rejection under 35 USC 102 as note below (in bold type):

- **The Applicant stated the claim limitations were compared with the sections of Sehr cited in the Office Action and based on this comparison, Sehr falls short of teaching every element of Applicant's amended independent claims.**

The Applicant amended independent claims to more clearly and distinctly claim the invention. As previously claimed there was no claim to actually allowing the customer to print a ticket, just the system receiving a printed ticket from the customer. Sehr discloses a printer and discloses allowing the customer to print out the electronic ticket or presenting the ticket in electronic form. The previous Office Action cited printing a ticket on page 6

- **Sehr teaches against using printed tickets.**

Sehr discloses the card center providing a printer for the purpose of printing the electronic ticket, expense reports, and other documents by the customer (see at least Fig. 1 (15); col. 7, lines 10-15), and discloses the customer using the ticket in electronic form.

The Applicant cited disclosures from Sehr in page 12 of the Remarks to support Sehr's teaching away from the Applicant's invention. Sehr,

however, clearly recognizes the need for paper-based ticket versions by providing a printer for printing hard-copy tickets. Sehr, however, never mentions totally eliminating paper-based equivalents as evidenced by printing an electronic ticket, a boarding pass associated with an electronic ticket, and a speeding ticket.

- **Sehr does not teach or suggest anything to do with printed layout information and therefore does not teach or suggest sending printed layout information to the customer including security features.**

The electronic ticket is transmitted to the user's card. Inherent in printing the ticket is layout information necessary to render the printed ticket useful to those receiving the ticket from the customer.

- **The Office Action is void of any contention that Sehr teaches or suggests making sure that a merchant is authorized to receive the customer's security information from a server before being allowed to access the information.**

Sehr discloses data and information relating to the transportation carriers, travel services, payment forms, and card configurations being earmarked electronically, and by example discloses identification numbers or security keys. Sehr further discloses recipients (e.g. service providers) having identifications numbers or security keys (see at least 4, line 67 through col. 5, line 3; col. 17, lines 43-65; col. 19, lines 34-65). Sehr teaches client/server architecture, and a centralized computerized means

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for managing the distributed system (see at least Fig. 2 (2); col. 6, lines 66-67; col. 4, lines 44-53).

- **Sehr does not teach or suggest authorizing the merchant in accessing the customer's account data located on a security server.**

Sehr teaches access control mechanisms and access rights by entities attempting to access the electronic data using identification or security keys as noted above (see at least col. 18, lines 37-56; col. 8, lines 29-34).

- **Sehr does not teach or suggest performing any sort of negotiation between a merchant and a customer as to what security features, or credentials, have been enabled.**

Sehr teaches passing security credentials between the user and provider in order to authorize access to services, and the provider enabling the card by storing provider information that is later requested and matched during the exchange (e.g. depositing providers digital signature on the card for later matching) (see at least col. 19, lines 34-65).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 1, 2, 5, 6, and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The claims are directed to a process that does nothing more than manipulate an abstract idea. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. There is no practical application in the technological arts to support the core invention. For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-6, 8-18, and 20 are rejected under 35 USC 103(a) as being unpatentable over Sehr (Paper #2, patent number 6,085,976).**

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Sehr teaches a method of providing electronic tickets and using customer security features to authenticate ticket use (see at least abstract; Fig. 1 (1, 2, 3, 4); Fig. 2 (2, 11, 32 3, 34); col. 1, line 8 through col. 3, line 40). Sehr further teaches:

- Receiving a ticket purchase: (see at least col. 6, lines 25-31; col. 7, lines 30-53; col. 8, lines 15-20).
- Receiving one or more security features from the customer: biometrics, fingerprints, voice, signature, digital signature, eye characteristics, and picture or facial features (see at least abstract; col. 1, lines 46-51; col. 6, lines 52-61).
- Sending a ticket identifier, storing a ticket identifier: (see at least col. 5, line 55 through col. 6, line 15; col. 8, lines 3-58).
- Storing security features: stores security features in a user's smart card and online databases (see at least col. 6, lines 15-38; col. 6, lines 52-61).
- Links to customer security images, requesting images, receiving images: (see at least col. 11, lines 59-62; col. 13, lines 4-37).
- Merchant identifier: codes to identify providers of products or services, account numbers (see at least col. 5, line 55 through col. 6, line 15; col. 8, lines 15-34).
- Processing payment and determining payment success: validation codes, validating payment (see at least abstract; col. 3, lines 21-25; col. 4, lines 31-35; col. 9, lines 31-35; col. 10, lines 21-62).

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- *Sending a customer enabled security features:* (see at least col. 19, lines 34-65).
- *Printing electronic ticket:* printing ticket (see at least col. 7, lines 10-15); stores boarding pass in electronic forms or prints boarding pass (see at least col. 34, lines 37-38); police officer issues a speeding ticket in electronic form including security features (e.g. ticket number, speed's name) and optionally prints the ticket (see at least col. 39, lines 1-4); printing a label pertaining to information relating to a ticket (see at least col. 10, lines 7-13).
- *Layout information:* Inherent in printing the ticket is layout information necessary to render the printed ticket useful.
- *Memory accessible by the processors:* (see at least col. 5, lines 12-48).
- *Network interface:* Internet, wired or wireless, (see at least col. 1, lines 39-41).
- *Means for:*
 - i. *Receiving a ticket purchase:* (see at least col. 6, lines 25-31; col. 7, lines 30-53; col. 8, lines 15-20).
 - ii. *Receiving one or more security features from the customer:* biometrics, fingerprints, voice, signature, digital signature, eye characteristics, and picture or facial features (see at least abstract; col. 1, lines 46-51; col. 6, lines 52-61).
 - iii. *Sending a ticket identifier, storing a ticket identifier:* (see at least col. 5, line 55 through col. 6, line 15; col. 8, lines 3-58).

- iv. Storing security features: stores security features in a user's smart card and online databases (see at least col. 6, lines 15-38; col. 6, lines 52-61).
- v. Storing security features: stores security features in a user's smart card and online databases (see at least col. 6, lines 15-38; col. 6, lines 52-61).
- vi. Linking to customer security images, requesting images, receiving images: (see at least col. 11, lines 59-62; col. 13, lines 4-37).
- vii. Identifying merchants: codes to identify providers of products or services, account numbers (see at least col. 5, line 55 through col. 6, line 15; col. 8, lines 15-34).
- viii. Processing payment and determining payment success: validation codes, validating payment (see at least abstract; col. 3, lines 21-25; col. 4, lines 31-35; col. 9, lines 31-35; col. 10, lines 21-62).
- Computer operable medium: software program used to implement the system's operational tasks and to execute various computerized means; use of computer readable medium (e.g. solid state memory, magnetic tape, rotating media, video disks, and optical/laser media) (see at least col. 5, lines 24-29).
- Printing security features:

Sehr teaches all the above as noted under the 103(a) rejection and teaches a) storing a user's biometric, photographic image data, and other identification data used for security purposes associated with an electronic

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ticket, b) viewing on a computer screen displayed security features associated with a displayed electronic ticket to authenticate the rightful owner, c) printing electronic tickets, d) printing a boarding pass after validating the electronic air travel ticket, and e) layout information, but does not disclose printing a security feature. It would have been obvious to one of ordinary skill in the art at time of the invention to implement printing a security feature on a printed ticket, since one of ordinary skill in the art would ascertain that printing a ticket or boarding pass with a security feature would accomplish the same security result as viewing a security feature on a computer screen used to authenticate the rightful owner of the displayed electronic ticket.

Pertaining to system Claims 9-12

Rejection of Claims 9-12 is based on the same rationale as noted above.

Pertaining to computer medium Claims 13-18, and 20

Rejection of Claims 13-18, and 20 is based on the same rationale as noted above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

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Any response to this action should be mailed to:

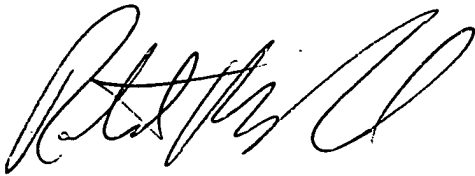
Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.

A handwritten signature in black ink, appearing to read 'R. M. Pond', with a large, stylized flourish at the end.

Robert M. Pond
Patent Examiner
August 23, 2004